PATENT
Attorney's Docket No. 003300-293

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of	
PER HOFVANDER, et al.	
	Group Art Unit: 1804
Serial No.: 08/070,455	
	Examiner: David T. Fox
Filed: June 9, 1993	
For: GENETICALLY ENGINEERED MODIFICATION OF POTATO TO FORM AMYLOPECTIN-TYPE STARCH	

RESPONSE

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

In complete response to the December 30, 1993 Official Action, Applicants elect with traverse the claims of Group I (i.e., Nos. 1 and 4 to 20) for immediate prosecution.

The reconsideration of the requirement for restriction respectfully is requested.

It respectfully is submitted that the subject matter of all claims could be conveniently examined in the same application. It is expressly stated in Claims 2 and 3 that the amylopectin-type natural starch is obtained from or extracted from a "potato which has been modified in a genetically engineered manner". A thorough search of the claimed subject matter of the claims of Groups I and II would be expected to encompass the same areas. It is urged that the examination of Claims 1 to 20 should not be considered to be unduly burdensome and that the same search would be required even if the claims of only one Group were examined.

It further is pointed out that the present application was filed in the United States pursuant to the terms of the Patent Cooperation Treaty. The terms of such treaty are fully binding upon the actions of the U.S. Patent and Trademark Office as a matter of law. Unity of invention with respect to all claims already has been found during the examination of International Application

PCT/SE91/00892.

Please see the decision of the U.S. District Court of the Eastern District of Virginia, Caterpillar Tractor Co. v. Commissioner of Patents and Trademarks, 231 U.S.P.Q. 590, (E.D. Va. 1986). Therein, it was found that the Patent and Trademark Office's requirement of restriction in an application filed under the Patent Cooperation Treaty was contrary to law.

In view of the foregoing factors, it is urged that the requirement for restriction between the claims of Group I and II is improper, and that all of Claims 1 to 20 are properly examinable in the present application. Accordingly, withdrawal of the requirement for restriction is urged to be in order and is thus respectfully requested.

From the foregoing reasons, substantive action on the merits of all claims of record hereby is respectfully requested.

Respectfully submitted,

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